

REMARKS

Claims 1-8 and 10-20 are pending. Applicants have cancelled claims 4, 5, 10, 11, 13, 14, 17, and 18 without prejudice. Claims 1-3, 6-8, 12, 15, 16, 19, and 20 will therefore be pending upon entry of the proposed amendments.

Claims Amendments

Applicants have amended claim 1 to remove non-elected subject matter. Claim 1 as presently amended also now requires that Y must be hydrogen, and Z must be substituted with one or more independently selected substituents recited in the definition of Z. Support for these amendments can be found throughout the specification, e.g., at page 4, lines 19-36 and the numerous working examples disclosed throughout the specification.

Applicants have amended claims 6, 8, 15, and 19 to comport in scope with claim 1 as presently amended.

Finally, claim 12 as presently amended no longer refers to claim 11 (now cancelled).

The foregoing amendments, which introduce no new matter, are being made for the sole purpose of expediting prosecution of the present application, and Applicants expressly reserve the right to pursue any cancelled subject matter in one or more continuing applications.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 10 and 11 are rejected for allegedly failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. Applicants respectfully disagree with the grounds for the rejection; however, to expedite prosecution of the present application, Applicants have cancelled claims 10 and 11, thus rendering the rejection moot.

Double Patenting

[1] Claims 1-8 and 10-20 are provisionally rejected on the ground on nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-6, 13-18, 22, and 24 of USSN 12/167,513 (Office Action, page 6).

[2] Claims 1-8 and 10-20 are provisionally rejected on the ground on nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 26-32 of USSN 12/089,276 (Office Action, page 7).

[3] Claims 1-8 and 10-20 are provisionally rejected on the ground on nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-11 of USSN 11/576,372 (Office Action, page 7).

[4] Claims 1-8 and 10-20 are provisionally rejected on the ground on nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-4, 6-8, 12, 13, 14, and 16-19 of USSN 10/552,082 (Office Action, page 7).

The rejection of claims 4, 5, 10, 11, 13, 14, 17, and 18 is moot in view of the cancellation of these claims. Please consider the remarks below.

Applicants will address these rejections once the present claims are otherwise in condition for allowance.

Rejections under 35 U.S.C. § 102

[I] Claims 1-8 and 10-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by "Matsura JP07140725" (Office Action, page 8; referred to below as "Matsura").

The Office relies on the purported disclosure of compounds in Matsura in which the substituent corresponding to Applicants' Z is unsubstituted phenyl. In contrast, claim 1 as presently amended requires that Z must be phenyl (or naphthyl) that is substituted with one or more independently selected substituents recited in the definition of Z. As such, the Matsura compounds fall outside of the scope of the present claims. Matsura therefore does not anticipate the present claims because Matsura does not teach a compound meeting all of the limitations of

the present claims. In view of the foregoing, Applicants respectfully request that the rejection be reconsidered and withdrawn.

[II] Claims 1-8 and 10-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by “Mattingly US5145790” (Office Action, page 9; referred to below as “Mattingly”).

The Office relies on the purported disclosure of compounds in Mattingly in which the substituent corresponding to Applicants' Y is chloro. In contrast, claim 1 as presently amended requires that Y must be hydrogen. As such, the Mattingly compounds fall outside of the scope of the present claims. Mattingly therefore does not anticipate the present claims because Mattingly does not teach a compound meeting all of the limitations of the present claims. In view of the foregoing, Applicants respectfully request that the rejection be reconsidered and withdrawn.

[III] Claims 1-8 and 10-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by “Dalal et al. Journal of the Indian Chemical Society (1949), 26, 549-52” (Office Action, page 10; referred to below as “Dalal”).

The Office relies on the purported disclosure of compounds in Dalal in which the substituent corresponding to Applicants' Z appears to be unsubstituted phenyl¹. In contrast, claim 1 as presently amended requires that Z must be phenyl (or naphthyl) that is substituted with one or more independently selected substituents recited in the definition of Z. As such, the Dalal compounds fall outside of the scope of the present claims. Dalal therefore does not anticipate the present claims because Dalal does not teach a compound meeting all of the limitations of the present claims. In view of the foregoing, Applicants respectfully request that the rejection be reconsidered and withdrawn.

¹ The rejection indicates that “Z is Aryl (phenyl substituted with halogens,” however, the chemical structures indicate that the substituent corresponding to Z in the Dalal compounds relied upon by the Office is unsubstituted phenyl.

[IV] Claims 1-8 and 10-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by "Hazlet et al. Journal of the American Chemical Society (1941), 63, 1890-2" (Office Action, page 10; referred to below as "Hazlet").

The Office relies on the purported disclosure of compounds in Hazlet in which the substituent corresponding to Applicants' Z appears to be unsubstituted phenyl². In contrast, claim 1 as presently amended requires that Z must be phenyl (or naphthyl) that is substituted with one or more independently selected substituents recited in the definition of Z. As such, the Hazlet compounds fall outside of the scope of the present claims. Hazlet therefore does not anticipate the present claims because Hazlet does not teach a compound meeting all of the limitations of the present claims. In view of the foregoing, Applicants respectfully request that the rejection be reconsidered and withdrawn.

Applicants submit that all claims are in condition for allowance.

No fee is believed due. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 06275-0474US1/101016-1P US/R&I.

Respectfully submitted,

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/John T. Kendall/

John T. Kendall, Ph.D.

Reg. No. 50,680

Customer Number 26164
Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (877) 769-7945

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² The rejection indicates that "Z is Aryl (phenyl substituted with halogens," however, the chemical structures indicate that the substituent corresponding to Z in the Hazlet compounds relied upon by the Office is unsubstituted phenyl.